



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,747	10/22/2003	Jack D. Pryor	PA1548	7767
<div>7590      05/07/2007</div> <div>Janis J. Biksa Medtronic Vascular, Inc. IP Legal 3576 Unocal Place Santa Rosa, CA 95403</div> <div>EXAMINER GETTMAN, CHRISTINA DANIELLE</div> <div>ART UNIT      PAPER NUMBER 3734</div> <div>MAIL DATE      DELIVERY MODE 05/07/2007      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/691,747

Applicant(s)

PRYOR, JACK D.

Examiner

Christina D. Gettman

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 2-19, 32 and 36-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 20-31, 33-35 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/04/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species:

Species I: Fig. 1-3

Species II: Fig. 4, 5A, 6

Species III: Fig. 5B

Species IV: Fig. 7

Species V: Fig. 8

Species VI: Fig. 9

Species VII: Fig. 10

Species VIII: Fig. 11

Species IX: Fig. 12

The species are independent or distinct because each species has a different embodiment and structural design.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 20-24, 27-30, 33, 34, and 43 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

Art Unit: 3734

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Serge Hodgson on April 9, 2007, a provisional election was made without traverse to prosecute the invention of species 1, claims 1, 20-31, 33-35, and 43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-19, 32, and 36-42 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 20-25, 27-30, 33, 34, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Monroe et al. (U.S. Patent No. 6,113,608). Monroe et al. disclose a stent delivery system including a housing (ref. 124, fig. 1), a sheath (ref. 112, Fig. 1), a slider (ref. 120, Fig. 1 by ref. 104, Fig. 1), an engagement plate (ref. 164, Fig. 1), a

Art Unit: 3734

source of stored energy being a spring (ref. 160, Fig. 1 acts like a spring), an anchor plate (above ref. 136, Fig. 1), a stent constrained by the sheath (ref. 148, fig. 1), an inner member surrounded by the stent (see ref. 108, Fig. 1), a slider movement mechanism (ref. 144, Fig. 1), mean for connecting the slider to the engagement plate (through ref. 104, fig. 1), and a method of using the device to deploy a stent (col. 3-4; fluid is poured into the piston housing, the spring is contracted and pushes stent out into the vessel as well as retracts the sheath, the stent self-expands, and the spring pushes outward further retracting the sheath from the stent as well as pushing the stent out from the sheath).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monroe et al. as applied to claim 1 and 27 above, and further in view of Von Oepen et al. (U.S. Patent No. 2006/0142833). Monroe et al. disclose the invention substantially as claimed except for locking protrusions and locking apertures. Von Oepen et al. teach locking protrusions and locking apertures (ref. 106-108, Fig. 4-6) for the purpose of locking the slider to the engagement plate. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Monroe et al. with locking protrusions and locking apertures in order to help

Art Unit: 3734

retract the sheath from the stent during deployment and to lock the slide with the engagement plate.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Levin et al. (U.S. Patent No. 8,168,606) discloses a lancet device that propels the needle out of the orifice but the use of a spring, housing, and locking protrusions and locking apertures. Bicek et al. (U.S. Patent No. 6,206,888) disclose a stent delivery system that incorporates the use of a spring, a sheath, a stent, and an inner shaft that the stent surrounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina D. Gettman whose telephone number is 571-272-3128. The examiner can normally be reached on Monday-Friday 7:15 am to 3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG  
  
Christina Gettman  
Art Unit 3734  
571-272-3128

  
MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER